the same grounds, that is alleged new matter introduced in the amendment of February 10, 2000. Applicants seek reconsideration and submit that no new matter has been entered in this case and that a supplemental oath or declaration is not required. Nor is it necessary or appropriate that this application be designated as a continuation-in-part.

The starting point for a determination of whether matter entered by amendment into an application is "new" matter is whether to the original specification, read by one of ordinary skill in the art, would reasonably convey to that person that the inventor had possession of the subject matter later claimed, i.e., the subject matter of Claims 35-37 and 44. In this connection, see Waldemar Link GmbH & Co., The Osteonic Corp., 31 U.S.P.Q. 2d 1855 (Fed. Cir. 1994).

At page 5 of the Office Action, the Examiner acknowledges that, in making the amendment to the disclosure, the applicants have used the "numerous relations disclosed throughout the specification." In asserting that the applicants have arbitrarily selected preferred values which are admitted by the Examiner to be disclosed in the original Specification, the Office Action ignores the fact that the disclosure is directed to one of ordinary skill in the art, in this case a very sophisticated art with very high levels of skill.

The Office Action also overlooks the fact that the target body of the present invention must be construed in the context of the claimed magnetron atomization source which is the subject

matter of U.S. Patent No. 5,688,381 upon which the present application is based. In constructing a magnetron atomization source in the manner shown in the figures of this application (as well as the identical figures in the parent patent), that person of ordinary skill would also recognize that the construction of the atomization source includes the circular target body and its geometrical relationships to the overall structure. In this connection, the Office Action appears to conclude that the disclosed and claimed values are "arbitrarily selected preferred values" and that there is no specific teaching of the "various steps cited in the order indicated" in the amendment, but in doing so steps outside the role of one of ordinary skill into the shoes of one who has no familiarity whatsoever in the design of magnetron atomization sources.

In the rejection of Claims 35-37 and 44 under 35 U.S.C. §112, first paragraph, the Office Action refers to "critical" feature or limitation. Applicants submit that the designation of a limitation as "critical" does not change the basic ground rules for deciding whether something is or is not new matter and certainly does not create a higher standard of disclosure as may be implied from the contention in the Office Action. We would also submit that the "sequentially disclosed" assertion in the Office Action has no merit whatsoever. The derivation of the relationships in the amendment to page 11 between lines 15 and 16 merely follows the logical reasoning to one skilled in the art of designing magnetron atomization sources and their necessary

circular target bodies based upon the "numerous relationships disclosed throughout the specification." There is nothing arbitrary about the selection of such preferred values, and the manner in which applicants have set forth the derivation of the claimed relationship regarding, d_0, is merely the exercise of ordinary skill, not inventive skill, based upon what is acknowledged by the Examiner to be disclosed.

An example of the flaw in the reasoning set forth in the Office Action is found at pages 4 and 5 thereof where, on one hand, the Examiner points to the fact that the Applicants recite a preferred distance a of 30% d_{113}. On the other hand, however, the Examiner maintains that the skilled artisan would not have been led to such a preferred distance without the specific teachings of the new matter presented in applicants' amendment to the specification. We have already pointed out, however, that this very teaching is specifically found at page 11, lines 13-15 of the original Specification.

Applicants are not asserting that the material added at page 11, between lines 15 in the response of February 10, 2000, was disclosed in those exact words in the original disclosure. If that were the case, of course, there would have been no purpose for adding the amendment. But, that is not the test for whether something does or does not constitute <u>new</u> matter. The skilled engineer in the design of magnetron atomization sources would unquestionably be led to the relationship set forth in Claim 44 based upon the original disclosure coupled with the

accumulated knowledge of the high level of skill possessed by the artisan in this field. All that applicants have done in their amendment is to regroup or reorder the original disclosure and to more specifically define the logical inferences that would be apparent to one of ordinary skill in the art. That is, the equations (1) through (6) in the amendment merely recite what is already disclosed in the application, as acknowledged by the Examiner, or what is clearly derivable therefrom without the exercise of any inventive skill.

For the foregoing reasons, the objections to the Declaration and to the specification, as well as the rejection of the claims, are not well founded. Reconsideration and favorable action upon the claims in this application, including new claim 45, are earnestly solicited.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and shortages in other fees, be charged, or any overpayment in fees

be credited, to the Deposit Account of Evenson, McKeown, Edward & Lenahan, P.L.L.C., Account No. 05-1323 (Docket #622/42052DV).

Respectfully submitted,

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